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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,263	10/02/2003	Fumihisa Kitawaki	43888-278	3473
7590 03/22/2006 MCDERMOTT, WILL & EMERY 600 13th Street, N.W. Washington, DC 20005-3096			EXAMINER VENCİ, DAVID J	
			ART UNIT 1641	PAPER NUMBER
DATE MAILED: 03/22/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/676,263	Applicant(s) KITAWAKI ET AL.	
	Examiner David J. Venci	Art Unit 1641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on December 8, 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-22 is/are pending in the application.
- 4a) Of the above claim(s) 11-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1,2 and 4-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on December 8, 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1641

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 8, 2005 is entered.

Claims 11-22 are drawn to a non-elected invention and were withdrawn from consideration in the Office Action dated April 7, 2005.

Currently, claims 1-2 and 4-10 are under examination.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Art Unit: 1641

Drawings

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because different reference characters are used to designate the same structural details. For example:

reference characters "53" (Fig. 9) and "40" (Fig. 9) are both used to designate "member" or "handling device"

Art Unit: 1641

Claim Rejections - 35 USC § 112

1,2 & 4-10

Claims ~~3-5~~ are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1-2 and 4-5, the recitation of "an analyte" is indefinite. Whether "an analyte" is a required structural limitation of the device of claim 1 is not clear.

In claim 1, the recitation of "capable of quantitatively collecting and temporarily retaining an analyte" is indefinite. Whether/how the phrase "capable of quantitatively collecting and temporarily retaining an analyte" structurally limits claim 1 is not clear. The identity of structural limitations, if any, required for ascertaining "quantitatively collecting and temporary retaining" is not clear.

In claim 1, the recitation of "a change in a magnetic field" lacks antecedent causal basis. The cause of "a change in a magnetic field" is not clear. Whether/how the phrase "a change in a magnetic field" structurally limits claim 1 is not clear. The identity of structural limitations, if any, required in claim 1 for "a change in a magnetic field" is not clear.

In claim 2, the recitation of "retains said analyte by capillarity" is indefinite. Whether/how the phrase "retains said analyte by capillarity" structurally limits claim 2 is not clear. The identity of structural limitations, if any, required for ascertaining retention "by capillarity" is not clear.

In claim 4, the recitation of "releases said analyte in response to the movement of said second region" is indefinite. The identity of structural limitations, if any, required for "movement of said second region" is not clear.

Art Unit: 1641

In claims 5-6, 8 and 10, the recitation of "a1" and/or "b1" is indefinite. The identity of object(s) belonging to the class "a1" and "b1" is not clear. The standard for ascertaining class memberships is not clear.

Art Unit: 1641

Claim Rejections - 35 USC § 102**1-2, 4-10**

Claims **1-2, 4-10** are rejected under 35 U.S.C. 102(e) as being anticipated by Colbert *et al.* (US 6,824,755).

Colbert *et al.* teach an analyte sampling element (see col. 4, line 13, "[n]anoscale [d]evices") comprising a first region (see col. 10, lines 16-18, "surfaces and other substrates... biomolecules") capable of quantitatively collecting and temporarily retaining an analyte (see col. 14, lines 23-24, "a chemical moiety that acts as a catalyst"), and a magnetic second region (see *e.g.*, col. 12, lines 25-26, "charge density waves"; col. 13, line 9, "electromagenetic fields") adjacent and connected to the first region (see col. 10, lines 16-18, "surfaces and other substrates... biomolecules"), wherein a dynamic effect (see col. 13, line 53, "forces") acts on the second region (see *e.g.*, col. 12, lines 25-26, "charge density waves"; col. 13, line 9, "electromagenetic fields") from outside the second region (see col. 10, lines 16-18, "surfaces and other substrates... biomolecules") to move (see col. 13, lines 46-47, "manipulation or modification of objects") said first region (see col. 10, lines 16-18, "surfaces and other substrates... biomolecules"), wherein said dynamic effect is caused by a change in a magnetic field (see col. 13, lines 54-55, "magnetic force").

Response to Arguments

In prior Office Action, the drawings were objected to as failing to comply with 37 CFR 1.84(p)(4) for allegedly using both reference characters "1" (Fig. 1) and "11" (Fig. 2) to designate "sampling element". Upon further review, this objection appears to have been made in error. Accordingly, this objection is withdrawn.

In prior Office Action, claims 1-10 were rejected under 35 U.S.C. 102(e) as being anticipated by Kellogg *et al.* (US 6,632,399). In response, Applicants have amended independent claim 1 to add, inter alia, a magnetic second region "adjacent and connected" to the first region. Applicants argue Kellogg *et al.* do not disclose a device comprising a magnetic second region "adjacent and connected" to the first region (see Applicants' reply, p. 15, first full paragraph, "Kellogg *et al.* do not disclose that its electromechanical means are adjacent and connected to the metering capillary"). Applicants' claim amendments and arguments have been carefully considered and are fully persuasive and sufficient to overcome the grounds for rejection set forth in the prior Office Action. Accordingly, this rejection is withdrawn.

Art Unit: 1641

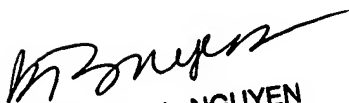
Conclusion

No claims are allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Venci whose telephone number is 571-272-2879. The examiner can normally be reached on 08:00 - 16:30 (EST). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

David J Venci
Examiner
Art Unit 1641

djv


BAO-THUY L. NGUYEN
PRIMARY EXAMINER
3/20/06